

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Finlay et al.	Art Unit	: 1624
Patent No.	: 7,485,644	Examiner	: Erich A. Leaser
Issue Date	: February 3, 2009	Conf. No.	: 5927
Serial No.	: 10/561,747		
Filed	: December 21, 2005		
Title	: N-{4-SUBSTITUTED PIPERAZINE-1-SULFONYLMETHYLALKYL}-N-HYDROXYFOMAMIDE COMPOUNDS AS METALLOPROTEINASE INHIBITORS		

Commissioner for Patents
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 277 to 321 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 FSupp2d 138; 88 USPQ2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under

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35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before February 21, 2007 (the date that is fourteen months after December 21, 2005, the date on which the application was filed). The PTO mailed the first non-final Office Action on January 25, 2008, thereby according a PTO Delay of 338 days. Patentee does not dispute the PTO's calculation for this “A Delay” from February 22, 2007 (the day after the date that is fourteen months after the date on which the application was filed), to January 25, 2008. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 338 days.

“B Delay”

The period beginning on December 22, 2008 (the day after the date that is three years after the date on which the application was filed), and ending February 3, 2009 (the date the patent was issued), is 44 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent

was issued. In the present application, no Request for Continued Examination was filed. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In view of the period of "B Delay" detailed above, the total "B Delay" for this patent is calculated as a total of 44 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 44 days.

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

February 22, 2007, to January 25, 2008.

As detailed above, "B Delay" accumulated during the following period:

December 22, 2008, to February 3, 2009.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before April 25, 2008 (the date that is three months after January 25, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 25, 2008, thereby according an Applicant Delay of 61 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from April 26, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to June 25, 2008. See 37 C.F.R. § 1.704(b).

In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 61 days.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

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Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 277 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 382 days (i.e., the sum of 338 days of "A Delay" and 44 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 61 days; and
- 3) Total PTA should be calculated as 321 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 06275-0487US1.

Respectfully submitted,

Date: April 2, 2009

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